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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/847,298   | 05/03/2001  | Christian Walsdorff  | 51416               | 5427             |
| 26474  | 7590        | 05/05/2004           | EXAMINER            |                  |
| KEIL & WEINKAUF<br>1350 CONNECTICUT AVENUE, N.W.<br>WASHINGTON, DC 20036 |             |                      | JOHNSON, EDWARD M   |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1754                |                  |

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                  |
|------------------------------|-------------------------------|------------------|
| <b>Office Action Summary</b> | Application No.               | Applicant(s)     |
|                              | 09/847,298                    | WALSDORFF ET AL. |
|                              | Examiner<br>Edward M. Johnson | Art Unit<br>1754 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 November 2003.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 2,3 and 5-12 is/are pending in the application.  
 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 2,3,5,6 and 12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2-3, 5-6, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Courty et al. US 4,381,415.

Regarding claim 12, Courty '415 discloses a catalyst comprising delta alumina carrier (see column 3, lines 55-60), which would inherently correspond to a detectable amount.

Regarding claim 2, Convers '699 specifies the carrier selected from eta, gamma, chi, kappa, theta, delta, or rho alumina (see column 3, lines 55-60).

Regarding claim 3, Convers '699 discloses 0.05-0.6% copper and 0.1-1% potassium (see column 3, lines 34-38).

Regarding claims 5-6, Convers '699 discloses impregnation of the active elements on carrier (see column 3, lines 64-68) and copper chloride (see Example 3).

3. Claims 2-3, 5-6, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Convers et al. US 4,460,699.

Regarding claim 12, Convers '699 discloses an oxychlorination catalyst comprising a gamma, eta, or delta alumina carrier (see column 4, lines 51-61), which would inherently correspond to a detectable amount.

Regarding claim 2, Convers '699 discloses about 17.1% and 22.6% of the catalyst (see Examples 3-4).

Regarding claim 3, Convers '699 discloses 1-7 percent copper (see column 5, lines 25-26), lithium, sodium, potassium, rubidium, or cesium on a 0.05 to 1.0 molar basis relative to copper (see column 5, lines 29-35), and a surface area of 100-200 square meters per gram (see column 4, lines 62-66).

Regarding claims 5-6, Convers '699 discloses impregnating 1-7 percent copper (see column 5, lines 25-26 and Example 1), lithium, sodium, potassium, rubidium, or cesium on a 0.05 to 1.0 molar basis relative to copper using copper chloride (see column 5, lines 29-35 and Examples), and a surface area of 100-200 square meters per gram (see column 4, lines 62-66).

***Response to Arguments***

4. Applicant's arguments filed 11/7/03 have been fully considered but they are not persuasive.

It is argued that neither reference anticipates... fluidized bed catalyst. This is not persuasive because oxychlorination catalysts are disclosed and, in any case, fluidized

oxychlorination is merely an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicant's apparent assertion that the claimed catalyst is different because of such recitations is also not persuasive because the disclosed particulate surface area is the same as Applicant's (see canceled original claim 4).

#### **Conclusion**

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS

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of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward M. Johnson whose telephone number is 571-272-1352. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0987.

EMJ

  
STANLEY S. SILVERMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700